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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,782	11/01/2000	Rudolf Pfaendner	A-20746/A/CGM 471/CIP	1730

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS7

Office Action Summary

Application No.
09/703,782

Applicant(s)
Pfaendner et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 27, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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1. Claims 2, 3, 14-17, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 2, applicants have specified that polyfunctional compounds, including secondary aromatic amines, are employed; however, the secondary amines of claims 14 and 15 are not required to be polyfunctional. The vast majority of the compounds encompassed by claim 14 contain a single amine group. The compound of claim 15 contains a single amine group. It is unclear how these compounds can be considered to be polyfunctional.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

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the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 4-9, 18, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaku et al. ('769).

The reference discloses the blending and reaction of dicyanates which correspond to those of applicants with polymers which correspond to those of applicants. See abstract.

4. Claims 1, 4-9, 18, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Khanna et al. ('896).

The reference discloses the blending and reaction of dicyanates which correspond to those of applicants with polymers which correspond to those of applicants. See abstract.

5. Applicants have argued that the references are drawn to curable or cured resins or resin systems; therefore, they do not anticipate a system which remains in the thermoplastic state. In response, the examiner has carefully reviewed all of the cited references in view of applicants' argument. The teachings of Gaku et al. and Khanna et al. are clear that the disclosed systems are melt processable. Gaku et al. are concerned with the production of a hot melt adhesive, and it is noted that applicants' claims are silent with respect to limitations that may have a bearing after the adhesive is ultimately applied. Khanna et al. are concerned with the production of polymers which are blow moldable, and Khanna et al. further specifically teach that the resulting

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compositions have melt viscosities and melt elasticities which exceed those of the initially added polyamide. These properties denote a high degree of thermoplastic behavior, which is in keeping with applicants' claims. Therefore, despite applicants' argument, it is not seen how the respective processes and compositions differ.

6. Claims 1-13, 16-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 604,367 or WO 95/35343, each in view of Gaku et al. ('769) or Khanna et al. ('896).

The primary references disclose the blending of phosphonic esters or diphosphonites, optionally with difunctional epoxides, with polycondensates to increase the molecular weight of the polycondensates.

7. The primary references are silent regarding the addition of aromatic dicyanates to the compositions; however, the use of dicyanates to modify polymer properties was known at the time of invention. This position is supported by the secondary references. Since it has been held that it is *prima facie* obvious to add a known ingredient for its known function (*In re Linder*, 173 USPQ 356; *In re Dial et al.*, 140 USPQ 244), and since it has been held *prima facie* obvious to combine components, each of which is known to have the same utility, to yield a composition which is to be used for the same purpose (*In re Kerkhoven*, 205 USPQ 1069), the position is taken that it would have been obvious to incorporate aromatic dicyanates into the compositions of the primary references, because one would have reasonably expected the dicyanates to perform their polymer modifying functions within the compositions of the primary references.

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8. In response to applicants' arguments, applicants are directed to the remarks set forth within paragraph 5, concerning the thermoplastic characteristics of the compositions within the relied upon secondary references.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent

November 3, 2002


RABON SERGENT
PRIMARY EXAMINER